

Appl. No. : 10/073,070  
Filed : February 7, 2002

### REMARKS

Claim 32 has been amended to correct an inconsistency. The changes made to the Specification and Claims by the current amendment, including deletions and additions, are shown herein with ~~deletions~~ designated with a strikethrough and additions underlined. No new matter has been added herewith. As a result of the amendments, Claims 1, 3-9, 11-13, 16-27, 29-32, and 34-46 are presented for further examination.

#### Rejection under 35 U.S.C. §112, second paragraph

Claim 32 was rejected as being indefinite as to the limitation "ethylene-propylene-diene rubber, ethylene-butene-diene rubber, ethylene-octene-diene rubber, and mixture therein. Because the Examiner states that the claim which it is dependent on, Claim 26 does not teach a diene component. However, claim 32 has been amended to remove any reference to diene components, rendering the rejection moot.

#### Rejection under 35 U.S.C. §103(a)

Claims 1, 3-9, 11-13, 16-27, 30-32, and 34-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schauder, U.S. patent 6,383, 439 ('439) in view of Oliver, U.S. patent 4,594,386 ('386). More specifically, the Examiner believed that Schauder ('439) taught all of the claim elements except that the ethylene-alpha-olefin elastomer is without a diene component. The Examiner further asserted that it would have been obvious to replace the part of an ethylene-alpha-olefin elastomer having a diene component of from 1-12% in the Schauder invention with EPM rubber from the Oliver invention which would eliminate the diene component and thereby obtain the claimed invention. Applicants respectively disagree.

The law is clear that three basic criteria must be met to establish a *prima facie* case of obviousness: (MPEP ¶2143):

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1440 (Fed. Cir. 1991).

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Failure to establish any one of these three requirements precludes a finding of a *prima facie* case and, without more, entitles Applicant to allowance of the claims at issue.

Amended Claims 1 and 26 teach the step of pelletization and that the specific ethylene- $\alpha$ -olefin "has an ethylene content of from about 30 wt% to about 75 wt% without diene components".

1. The combined references do not teach all of the claim elements because neither Schauder '493 nor Oliver '386 includes the step of pelletization.

2. There is no motivation to combine the step of pelletization with the composition taught by Schauder '493 and/or that taught by Oliver '386. In fact, it would have been contrary to the teachings in the art. As stated in the Specification, previously, it was believed that an ethylene content of at least **70wt% or more** was necessary for pelletization (see paragraph 6 of the specification, page 2). Thus, knowing that the method involves pelletization, one of skill in the art would not have pelletized the composition taught by Schauder '493 and/or that taught by Oliver '386.

3. Even if the references did teach the step of pelletization, there is no motivation to replace the ethylene-alpha-olefin elastomer of Schauder with the EPM rubber in the Oliver invention. There is no specific teaching in either of the references of the diene component, how it differs from the non-diene component or why one would want to replace it. There is no teaching or motivation to remove the diene component.

In view of the arguments, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103(a).

### **Conclusion**

Should there be any remaining questions, the Examiner is respectfully requested to contact the undersigned at the telephone number appearing below.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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